

Application No. 10/663,108
Amendment dated November 12, 2004
Reply to Office Action of July 12, 2004

REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed July 12, 2004. A petition and fee for a one month extension of time is attached. Any additional fees in connection with this Amendment should be charged to our Deposit Account No. 19-3320.

In the Office Action, the Examiner rejected claims 7-9 under 35 U.S.C. § 112, second paragraph, as being "indefinite;" rejected claims 1-2 and 7-9 under 35 U.S.C. § 102(b) as being "anticipated" by U.S. Patent No. 4,942,742 (*Burruel*) and by U.S. Patent Publication No. 20040094043 (*Morgan*); and rejected claim 6 under 35 U.S.C. § 103(a) as having been "obvious" over *Burruel* or *Morgan*. The Examiner indicated that claims 3-5 would be allowable if rewritten in independent form to include all of the limitations of their respective basic claims and any intervening claims.

In this Amendment, Applicant has canceled claims 1, 2 and 7-9, without prejudice, and has amended claims 3-6. This application now contains a total of four claims, all of which are written in independent form.

Further to the Examiner's statement of allowable subject matter, Applicants' amended claims 3-5 are essentially original claims 3-5 rewritten in independent form to include all the limitations of their original respective base claim and any intervening claims. As indicated by the Examiner, claims 3-5, as presently written, should be in a condition for immediate allowance.

Claim 6 has been rewritten in independent form and Applicant respectfully requests reconsideration of the rejection of the claim as being "obvious." To establish "obviousness": (1) the prior art itself must suggest or motivate the modification of a reference, (2) there must be a reasonable

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expectation of success, and (3) the prior art must teach or suggest all of the claimed limitations. M.P.E.P. § 2143. In this case, the cited prior art does not teach or suggest, even when combined, all of the claimed limitations. It is respectfully submitted that there is no teaching or suggestion in either *Morgan* or *Burruel* for providing a tray having a mold made of rubber, let alone vulcanized rubber. Morgan in fact teaches away from the holder claimed in claim 6 by disclosing hard materials for the mold, stating that "[b]oth sheets or trays are preferably constructed of integrally constructed of sheet steel or stainless steel but can be constructed of copper, aluminum, cast iron, pyrex, glass, porcelain, ceramic or any type of microwaveable material at a uniform desired thickness commonly used for baking pans and containers." (par. 0048).

Thus the references relied on by the Examiner, even if combined, fail to teach or suggest all of the claimed limitations of amended claim 6. If an individual element of a claimed combination is not present, either expressly or implicitly, in any of the references, then the claimed invention would not have been "obvious" from the references. MPEP 2143.03; *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-7 (Fed. Cir. 1983). It should also be noted that unsupported assertions of "common knowledge" or "common sense" to negate patentability based on obviousness is not proper. MPEP 2144.03; *In re Lee*, 61 USPQ2d 1430, 1434-35.

Applicant believes that *In re Leshin*, 125 USPQ 416 (CCPA 1960), does not apply here. *In re Leshin* involved a situation in which the "[m]ere selection of known plastics to make a container-dispenser of a type made of plastics prior to the invention," was considered "obvious." (emphasis added). That case involved a situation in which the Applicant had simply replaced one type of plastic with an alternate type of plastic. In direct contrast, Applicant is addressing an entirely differ-

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ent application than the problems addressed by the prior art references relied on, and is not simply substituting one type of plastic for another type of plastic. None of the prior art references in this case disclose a tray having a recess containing a mold made of rubber, let alone vulcanized rubber. The devices disclosed in both *Morgan* and *Burruel* are used for an entirely difference purpose than Applicants' device. The trays disclosed in *Morgan* and *Burruel* are used to form or cast a particular item, namely ice cubes and baking products, respectively. Such trays are not intended to be used to hold a previously formed or cast item for engraving purposes. Thus, there is simply no teaching or suggestion in either reference regarding a rubber mold that may be used to hold previously formed and multidimensional items that are inserted into the mold for the purposes of engraving. Accordingly, Applicant respectfully requests allowance of claim 6 as presently written and in light of these remarks.

This Amendment and these remarks are believed to be fully responsive to the Office Action mailed July 12, 2004, and are believed to squarely address each and every ground for rejection or objection raised by the Examiner, and are further believed to materially advance this application toward immediate allowance.

Formal allowance of claims 3-6, as amended, is, therefore, courteously solicited.

Respectfully submitted,

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